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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,463	06/30/2003	Ronan McNamee	171136-00003	1607
7590	10/19/2004		EXAMINER	
Carl M. Davis II Baker, Donelson, Bearman, Caldwell & Berkowitz Suite 900 Five Concourse Parkway Atlanta, GA 30328			HECKENBERG JR, DONALD H	
			ART UNIT	PAPER NUMBER
			1722	
DATE MAILED: 10/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/611,463	MCNAMEE, RONAN	
	Examiner	Art Unit	
	Donald Heckenberg	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) 8-12 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 June 2003 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date --.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

Art Unit: 1722

1. The PTO 1449 form included with the Information Disclosure Statement (IDS) filed on June 24, 2004 cites to references in the "U.S. Patent Documents" section with document numbers 10/611,462 and 10/611,469. These appear to be patent applications, and are therefore not properly listed under the U.S. Patent Documents section of the IDS. As such these citations have been crossed out on the initialed copy of the PTO 1449 attached to this Office Action. However, the file wrappers for these applications have been checked by the Examiner. In addition, the U.S. Patent Application Publications corresponding to these applications have been made of record with this Office Action.

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the Applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no

Art Unit: 1722

text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (d) BRIEF SUMMARY OF THE INVENTION.
- (e) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (f) DETAILED DESCRIPTION OF THE INVENTION.
- (g) CLAIM OR CLAIMS (commencing on a separate sheet).
- (h) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1722

4. Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Capodieci (U.S. Pat. No. 5,861,185).

Capodieci discloses an apparatus for the manufacture of food products. As shown in the embodiment depicted in Figure 10B, the apparatus comprises a cutting device which includes a plurality of cutting members (554). Each cutting member is adapted to be in contact with a strip of the material being processed for cutting a desired shape (551) out of the strip of material. Each cutting member is spaced apart from an adjacent cutting member in the transverse plane across the cutting apparatus by a predetermined distance so that each cutting member cuts a material cut-out (551) from the strip of material (fig. 10B). A narrow web of material is produced in the region between adjacent cutting members (the web being the material shown extending downward after the cutting operation in figure 10B), the width of the waste material corresponding to the predetermined distance by which adjacent cutting members are spaced from each other.

Capodieci further discloses the cutting members arranged linearly transversely across the apparatus so that, a single stroke of the cutting apparatus produces a line of cut-outs from the strip of material with the waste material separating adjacent cut-outs in the transverse plane (see fig. 10B). Each

Art Unit: 1722

cutting member is adapted to make sequential cutting strokes in a traveling longitudinal strip of material passing beneath the cutting apparatus on a moving conveyor (556).

It is noted that claims 1-4, 6, and 7 recite limitations directed at the intended use of the cutting apparatus. For example, the cutting apparatus to be used to cut dough, and that the cutting strokes are timed and spaced in a certain manner. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case, as Capodieci discloses an apparatus with the same structural features claimed, and it is readily apparent the apparatus is capable of operating in the claimed manner. Therefore, Capodieci anticipates all of the intended use limitations recited in claims 1-4, 6, and 7.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1722

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capodieci in view of Roth (U.S. Pat. No. 4,192,899).

Capodieci discloses the apparatus as described above. In various embodiments of the invention, Capodieci discloses cutting members designed to cut different shapes (see figs. 2, 3A, 3B, 3C, 7, and 10B). Capodieci however does not disclose one of the shapes of the cutting member to be generally oval so that each material piece is generally oval in shape.

Roth discloses an apparatus for cutting food products. In the one of the embodiments, Roth notes that the cutting members

Art Unit: 1722

can be formed in an oval shape in order for the product to be cut in an oval shape (see fig. 6 and cl. 4, ll. 52-59).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus disclosed by Capodieci as such to have used a cutting member in an oval shape because this would allow for oval shaped products to be formed as suggested by Roth.

8. Claims 8-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest an apparatus as defined in claim 8. The closest prior art disclosed by Capodieci is described above. Capodieci fails to teach or suggest the apparatus to comprise a waste web removing apparatus including at least one finger for urging the waste web upwardly for removal from the cut-outs while allowing for the cut-outs to remain in situ.

10. The following references cited but not relied upon are deemed pertinent to the instant application:

Bernard (U.S. Pat. No. 4,195,489) discloses an apparatus for portioning food.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions

Art Unit: 1722

on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
A.U. 1722